

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
AUSTIN DIVISION**


**Hammond Development International, Inc.,**

*Plaintiff,*

**v.**

**Amazon.com, Inc.,  
Amazon.com LLC,  
Amazon.com Services, Inc., and  
Amazon Web Services, Inc.,**

***Defendants.***



**Civil Action No. 1:20-CV-00342-ADA**

## Jury Trial Demanded

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
WACO DIVISION**

**Hammond Development International, Inc.,**

*Plaintiff,*

**v.**

**Google LLC,**

***Defendant.***



**Civil Action No. 6:19-CV-00356-ADA  
(consolidated with 6:19-CV-00355-ADA)**

## Jury Trial Demanded

## JOINT MOTION TO STAY PENDING *INTER PARTES* REVIEW

## **I. INTRODUCTION**

Plaintiff Hammond Development International, Inc. (“HDI”), Defendants Amazon.com, Inc., Amazon.com, LLC, Amazon.com Services, Inc., and Amazon Web Services, Inc. (collectively, “Amazon”), and Defendant Google LLC (“Google”) respectfully file this Joint Motion to Stay Pending *Inter Partes* Review (“IPR”) of the Patents-in-Suit.

## **II. FACTUAL AND PROCEDURAL HISTORY**

The Court consolidated for pre-trial purposes HDI’s actions against Amazon and Google on October 11, 2019. *See* Dkt. No. 38. On March 30, 2020, the Amazon case was transferred to the Western District of Texas, Austin Division, and placed under a new cause number. *See* Dkt. No. 65. Google’s separate Motion to Transfer is currently pending. *See* Dkt. No. 42. HDI has filed a notice of non-opposition to Google’s request to transfer to the Austin Division. *See* Civ. No. 6:19-CV-00356, Dkt. No. 36 (April 8, 2020). For the avoidance of doubt, this Joint Motion to Stay applies to both the Amazon and Google cases, and all references to “this action” or “this case” refer to both cases.

The Patents-in-Suit in this case are United States Patent Nos. 9,264,483 (the “’483 Patent”), 9,420,011 (the “’011 Patent”), 9,456,040 (the “’040 Patent”), 9,705,937 (the “’937 Patent”), 9,716,732 (the “’732 Patent”), 10,193,935 (the “’935 Patent”), 10,264,032 (the “’032 Patent”), and 10,270,816 (the “’816 Patent”) (collectively, the “HDI Patents”). On January 17, 2020, pursuant to the Scheduling Order entered in this case (Dkt. No. 48), HDI made its Preliminary Election of Claims, asserting the following claims against both Amazon and Google (“Asserted Claims”):

### **U.S. Patent No. 9,264,483:**

Claims 10, 12, 14, 15, 16, 17, 18, 22, 24, and 25

### **U.S. Patent No. 9,420,011:**

Claims 11, 16, 17, and 23

**U.S. Patent No. 9,456,040:**

Claims 3, 12, and 13

**U.S. Patent No. 9,705,937:**

Claims 3, 10, and 17

**U.S. Patent No. 9,716,732:**

Claims 4, and 5

**U.S. Patent No. 10,193,935:**

Claims 4, 8, and 10

**U.S. Patent No. 10,264,032:**

Claims 1, 2, 3, 5, 6, 7, 8, 9, 10, 11, 12, 14, 15, 16, 20, 22, and 23

**U.S. Patent No. 10,270,816:**

Claims 1, 6, 7, 8, 9, 10, 11, 12, 14, 15, 18, 19, 20, 24, 25, 27, 28, and 29

Between October 11, 2019 and June 9, 2020, Google and Amazon collectively filed twenty IPRs against the HDI Patents, each challenging, *inter alia*, each of the Asserted Claims. Both Amazon's and Google's deadlines to file IPRs against the HDI Patents have passed; thus, no additional IPRs will be filed. To date, the PTAB has instituted review in three of the pending IPRs. A summary of the pending IPRs (hereinafter, "HDI IPRs") and the status of each follows:

Case No.	Petitioner	Patent	Status
IPR2020-00020	Google	'483 Patent	Instituted – FWD expected by April 20, 2021
IPR2020-00080	Google	'032 Patent	Instituted – FWD expected by April 30, 2021
IPR2020-00081	Google	'816 Patent	Instituted – FWD expected by June 8, 2021
IPR2020-00214	Google	'732 Patent	POPR Filed – Institution decision expected by June 20, 2020
IPR2020-00298	Google	'040 Patent	POPR Filed – Institution decision expected by July 8, 2020
IPR2020-00305	Google	'732 Patent	POPR Filed – Institution decision expected by July 8, 2020
IPR2020-00306	Google	'935 Patent	POPR Filed – Institution decision expected by July 8, 2020

Case No.	Petitioner	Patent	Status
IPR2020-00411	Google	'011 Patent	POPR Waived – Institution decision expected by August 6, 2020
IPR2020-00412	Google	'040 Patent	POPR Waived – Institution decision expected by August 6, 2020
IPR2020-00413	Google	'935 Patent	POPR Waived – Institution decision expected by August 6, 2020
IPR2020-00414	Google	'937 Patent	POPR Waived – Institution decision expected by September 3, 2020
IPR2020-00415	Google	'937 Patent	POPR Waived – Institution decision expected by September 3, 2020
IPR2020-00460	Amazon	'483 Patent	POPR Waived – Institution decision expected by August 6, 2020
IPR2020-01029	Amazon	'032 Patent	Petition filed June 2, 2020
IPR2020-01043	Amazon	'732 Patent	Petition filed June 3, 2020
IPR2020-01051	Amazon	'040 Patent	POPR Due by September 9, 2020 – Institution decision expected by December 9, 2020
IPR2020-01058	Amazon	'011 Patent	POPR Due by September 9, 2020 – Institution decision expected by December 9, 2020
IPR2020-01064	Amazon	'935 Patent	POPR Due by September 17, 2020 – Institution decision expected by December 17, 2020
IPR2020-01066	Amazon	'937 Patent	POPR Due by September 17, 2020 – Institution decision expected by December 17, 2020
IPR2020-01067	Amazon	'816 Patent	Petition filed June 9, 2020

Based on the IPR schedules set forth in Title 35 of the United States Code (and assuming for purposes of this Motion that the PTAB will institute review in all twenty cases), Final Written Decisions (“FWDs”) in the HDI IPRs are expected to issue between April and December, 2021.<sup>1</sup>

This Court held its Markman hearing on May 15, 2020. The Parties have been negotiating a post-Markman schedule but have not yet reached agreement or submitted a proposal to the Court. Thus, discovery in this case has not yet begun and no trial date has been set.

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<sup>1</sup> The deadlines for HDI to file or waive its POPRs are based on the dates of the PTAB’s Notice of Filing Date Accorded for each Petition. 37 C.F.R. § 42.107(b). The PTAB has not yet issued its Notices in some cases listed in the chart, so HDI’s deadlines (which set the deadlines for the PTAB to issue its institution decisions and, consequently the deadlines for the FWDs) are not yet known.

### III. LEGAL STANDARDS

A district court has the inherent power to control its own docket, including the power to stay proceedings before it. *See Clinton v. Jones*, 520 U.S. 681, 706 (1997) (“The District Court has broad discretion to stay proceedings as an incident to its power to control its own docket.”). In particular, the question whether to stay proceedings pending *inter partes* review (“IPR”) of a patent is a matter committed to the district court’s discretion. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426–27 (Fed. Cir. 1988).

### IV. RELIEF REQUESTED

In light of the particular circumstances of this case, the Parties jointly request a stay of this action pending resolution of the HDI IPRs. Specifically, if the Court grants the requested stay in this case, the Parties stipulate as follows:

1. The case shall be stayed at least until the PTAB’s issuance of the last FWD in the HDI IPRs;
2. Upon issuance of the last FWD in the HDI IPRs, HDI shall provide a copy of all FWDs in the HDI IPRs to the Court.
3. If all Asserted Claims are found to be unpatentable in FWDs in the HDI IPRs, then the stay of this case shall be automatically extended pending HDI’s appeal(s), if any, of the FWDs in the HDI IPRs;
4. If any Asserted Claim is found to not be unpatentable in a FWD, then HDI may, following the PTAB’s issuance of the last FWD in the HDI IPRs, move the Court to lift the stay with respect to any such Asserted Claim, and Amazon and/or Google may oppose any such motion; and
5. HDI shall not assert against Amazon, Google, and/or any Amazon or Google products or services any patent claim in the Patents-in-Suit not listed in the Asserted Claims above in Section II.

Accordingly, the Parties respectfully request that the Court issue an Order staying this case and entering the requirements specified above. A Proposed Order consistent with this request is attached.

Finally, because the Parties and the Court have expended substantial time and resources on claim construction, and because “[a]ny prior claim construction determination concerning a term of the claim in a civil action . . . that is timely made of record in the *inter partes* review proceeding will be considered” in an IPR, 37 C.F.R. § 42.100(b), the Parties respectfully request that the Court enter its full Claim Construction Order when it is complete so that it may be submitted as part of the record in the HDI IPRs.

Dated: June 22, 2020

Respectfully submitted,

/s/ Andrew J. Wright

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**CERTIFICATE OF SERVICE**

Pursuant to Local Rule 5(b)(1), I hereby certify that the foregoing document was electronically filed with the Clerk of Court using the CM/ECF filing system, which will generate and send an e-mail notification of said filing to all counsel of record, on this the 22nd day of June, 2020.

/s/ Andrew J. Wright  
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